REMARKS

Initially, Applicant would like to inform the Examiner that the undersigned attorney has taken over prosecution of the subject application and that a revocation of power of attorney and a new power of attorney will be submitted shortly. Thus, with regard to this Amendment "A", the undersigned attorney is acting under 37 CFR §1.34.

Prior to this Amendment "A", claims 1-39 were pending in the subject application. In this Amendment "A", Applicant has amended claims 1, 8, 12, 16, 17 and 38; has canceled claims 9, 19-37 and 39; and has added claims 40-44.

In the Office action, the Examiner has rejected claims 1-39 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. The Examiner finds that the claims are directed to an abstract idea or a compilation of data. In addition, the Examiner states that "the statutory process must result in a physical transformation". Applicant submits that pursuant to established patent law and U.S. Patent Office practice, there is no requirement for a process (or machine, etc.) to result in a physical transformation. Indeed, the U.S. Patent Office's "*Interim Guidelines for Examination of Patent Applications for Patent Subject Mater Eligibility*", dated 26 October 2005 ("PTO Guidelines") states: "For eligibility analysis, physical transformation is not an invariable requirement, but merely one example of how a mathematical algorithm [or law of nature] may bring about a useful application" (page 20). The PTO Guidelines continue on to state that: "If the examiner determines that the claim does not entail the transformation of an article, then the examiner shall review the claim to determine if the claim provides a practical application that produces *a useful, tangible*

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and concrete result" (emphasis added).

The methods of claims 1-8, 10-18 and 40-44 and the system of claim 38 each produce a *useful, tangible and concrete* result. Generating an indication that the transformer design needs further analysis and displaying the indication on a display device is: *useful* because it produces a better transformer design; *tangible* because it produces a real world result, namely a display on a display device; and *concrete* because it can be repeated. Thus, Applicant submits that claims 1-8, 10-18, 38 and 40-44 meet the requirements of 35 U.S.C. §101 and notice to that effect is hereby respectfully requested.

The Examiner has rejected claims 1-39 under 35 U.S.C. §102(e) as being anticipated by PCT Application No. WO 00/072145 to Apfelbaum et al. Applicant traverses this rejection for at least the reasons set forth below.

The Apfelbaum et al. application discloses a method of analyzing a finite state machine model of *a system*. The only *system* the Apfelbaum et al. application discloses is a bank machine system. Thus, the Apfelbaum et al. application fails to disclose (with emphasis added): a "method" or "computing system" *"for evaluating a transformer design"*, as recited in the claims. For at least this reason, the Apfelbaum et al application fails to show or suggest the claims.

In addition to not being concerned with transformers, the Apfelbaum et al. application is concerned with analyzing a *finite state machine model* and not a design for a device, such as a transformer. As is well known, a *finite state machine model* is a model of behavior composed of states, transitions and actions. In other words, a *finite state machine model* strictly describes function and not structure. In contrast, a design

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specifies the structure and parameters of a device. Thus, the Apfelbaum et al. application fails to disclose (with emphasis added): a "method" or "computing system" "*for evaluating a transformer design*", as recited in the claims. For at least this additional reason, the Apfelbaum et al application fails to show or suggest the claims.

In addition to not being concerned with transformers or designs, the Apfelbaum et al. application does not disclose processing results from tests performed on an actual system (bank machine system), let alone tests performed on a transformer. Instead, the provisions in the Apfelbaum et al. application cited by the Examiner (abstract page 6, lines14-25; page 12, lines 10-24) disclose processing results from tests performed on the *finite state machine model.*   Thus, the Apfelbaum et al. application fails to show or suggest (with emphasis added):

> "*using data representing test results from a plurality of transformers*", as recited in independent claim 1;

> "*a database having test results for a plurality of transformers*", as recited in independent claim 38;

> "*results of a test performed on each of a plurality of transformers*", as recited in new independent claim 40.

For at least this additional reason, the Apfelbaum et al application fails to show or suggest independent claims 1, 38 and 40 and, thus, the claims depending therefrom.

Based on the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is

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invited to initiate a telephone interview with the undersigned attorney to expedite

prosecution of the present application.

   If there are any additional fees resulting from this communication, please charge

the same to our Deposit Account No. 050877.

                              Respectfully submitted,

                              ABB Research Ltd.

                              By: _____
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